

**REMARKS**

**I. Status of the Application**

Claim 1-12, 14-20, 23-41, 43-50, 52 and 53 are pending. With this amendment, Applicants have amended claims 1, 24, 34, 43, 45, 49 and 50. The amendments to the claims are supported by the application as filed. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Regarding the Examiner's note regarding intended use, the claims that use the term operative couple that term with an action and that term is preceded with a device or system. In this respect, the device or system, whether the video server, the AMS, the ADS, etc., has the claimed functionality. As such, a device or system that is operative to perform the claimed functionality is actually able to perform that functionality and not merely intending to perform that functionality. Accordingly, Applicants request that the Examiner consider the claim language in its entirety.

**II. Interview Summary**

Applicants' representatives thank Examiner Chornesky, for courtesies extended in granting and conducting the telephonic interview on September 9, 2011. Proposed amendments to claim 1 were discussed during the interview to better clarify the distinction between the claimed invention and the cited references, where the Examiner suggested further clarification with regard to the playlists. Specifically, Examiner suggested the addition of a first playlist and a second playlist. The present amendments to all the independent claims, consistent with the Examiner's suggestion, recite generating a first playlist in response to a customer request for an original program and a second playlist in response to a customer request for a previously recorded program. Applicants understand and appreciate that further searching may be performed. Examiner had indicated the addition of a first and a second playlist would put the application in condition for allowance. Applicants welcome Examiner Chornesky to contact the under signed attorney directly to resolve any concerns before issuing another office action.

**III. Claim Rejections**

**I. 35 USC §101**

The Examiner rejects claims 24-32 and 41 under 35 USC §101. Applicants has herewith amended claim 24 such that they are now tied to another statutory class. With respect to claims 24, the Examiner contends that the subject matter of these claims relates to non-statutory subject matter.

Applicant points the Examiner's attention to MPEP § 2106.01 which recites:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Claim 24 has been amended to recite, *inter alia*, that the "program" is "stored on a video server". Support for this amendment can be found at least at page 3, lines 7-8 of the originally filed application. The program is recorded (stored) on a video server (a computer readable medium) and is therefore statutory.

With regard to claim 41, claim 41 is dependent on independent claim 34, which was not rejected under 35 USC §101. Applicants submit that claim 41 is directed to statutory subject matter for the same reason that the examiner deems the subject matter

of claim 34 to be directed to statutory subject matter. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

**II. 35 USC §103**

In the Office Action, under 35 USC §103(a), the Examiner rejects claims 1-12 as being unpatentable over Carlucci (US PgPub 20040103429) in view of Bjorgan (US PgPub 20030066078), Lumley (US Pat 6588013) and Liga (US PgPub 20030154128); claim 15 as being unpatentable over Carlucci in view of Lumely, Liga, and Nathaniel (US PgPub 20030130887); claim 16 over Carlucci in view of Lumely, Liga, Nathaniel, and Zimmamia (US PgPub 20020161609); claims 24-31 as being unpatentable over Eldering (US PgPub 20020123928) in view of Swix (US Pat 6718551); claim 32 as being unpatentable over Eldering in view of Swix and Liga; claim 33 as being unpatentable over Eldering in view of Swix, Bjorgan, and Cowan (US Pat 6941573); and claims 43-50, 52, and 53 as being unpatentable over Eldering, in view of Cowan and Liga.

With regard to the 103(a) rejections of claims 1-23 based on Carlucci, Applicant submits that Carlucci cannot form the basis of a § 103(a) rejection. Carlucci, U.S. Publication No. 2010/0050218, and the present application were, at the time the claimed invention was made, commonly owned by the same entity or subject to an obligation of assignment to the same entity, Time Warner Cable Inc., therefore, a 35 U.S.C. § 103(c) exception applies. Applicants point out that Carlucci claims prior to U.S. Patent No. 7,610,606 which is assigned to Time Warner Cable Inc. Applicants note that evidence of the Carlucci assignment appears at reel/frame number 016241/0402. Applicants additionally note the assignment of the current application to Time Warner Cable Inc. appearing at reel/frame number 021884/0611. For at least this reason, Carlucci cannot be used as prior art in a § 103(a) rejection.

The other dependent claims are allowable for at least the same reasons as the claims from which they depend as well as for additional reasons.

Independent claim 24 as amended recites: “generating a first playlist utilizing a geographically zoned local advertisement and the requested program wherein the requested program is an original broadcast, and generating a second playlist utilizing a geographically zoned local advertisement and the requested program wherein the requested program is a previously recorded broadcast program” Applicants submit that the references cited by the Examiner fail to disclose this limitation of claim 1.

Claims 24, 34, 43, 45, 49 and 50 include a similar limitation as that of claim 24 noted above and are therefore patentable over the references cited by the Examiner for at least the same reason.

The dependent claims of the present application contain additional features that further substantially distinguish the invention of the present application over the prior art of record. Given the Applicants’ position on the patentability of the independent claims, however, it is not deemed necessary at this point to delineate such distinctions.

#### **IV. Conclusion**

For at least all the reasons above, Applicants respectfully request the withdrawal of all rejections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicants’ undersigned representative to discuss any issues relating to this application.

Respectfully submitted,

/ Antonio Papageorgiou/

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Antonio Papageorgiou  
Reg. No. 53,431  
Ostrow Kaufman LLP  
555 Fifth Avenue, 19<sup>th</sup> Floor  
New York, NY 10017  
212-682-9200 Ph.  
212-682-9222 Fx.

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